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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,951	12/12/2003	Christa Marie Bolig	HSJ920030217US1	1458

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EXAMINER

AFZALI, SARANG

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,951

Applicant(s)

BOLIG ET AL.

Examiner

Sarang Afzali

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-17, 19-20, 22-23 is/are rejected.
- 7) ☐ Claim(s) 18, 21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to an apparatus for handling and processing a workpiece, classified in class 29, subclass 760.
 - II. Claims 14-23, drawn to a method of handling a workpiece, classified in class 29, subclass 603.03.
2. Inventions of Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed in Group II can be practiced by another materially different apparatus such as one with cutting means, articulating means, and/or dismounting means to handle a workpiece.
3. In case the applicant elects Group I (claims 1-13), further restriction to one of the following inventions is required under 35 U.S.C. 121:
 - (a) Claims 1-7, drawn to an apparatus for handling workpieces, classified in class 29, subclass 759.
 - (b) Claims 8-13, drawn to an apparatus for processing workpieces, classified in class 29, subclass 760.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group (a) and Group (b) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group (a) does not require the detailed features stated in Group (b) such as a workpiece mounted to the fixture, cutting of the workpiece into pieces, and having a tray for receiving individual pieces for patentability. The subcombination has separate utility such as processing a workpiece and cutting the workpiece into pieces and using a tray with receptacles for receiving individual respective pieces and removing the pieces automatically from the fixture as defined in Group (b).

4. During a telephone conversation with Michael E. Noe, Jr. on 07-01-2005 an election was made without traverse to prosecute the invention of Group II, claims 14-23. Affirmation of this election must be made by applicant in replying to this office action. Claims 1-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A METHOD OF HANDLING A WORKPIECE.

6. The abstract of the disclosure is objected to because the abstract is not drawn to the claim invention, i.e. method. Correction is required. See MPEP § 608.01(b).

7. The disclosure is objected to because of the following informalities:

Section 15, lines 1-2 of the specification, the sentence seems to be incomplete and lacking a proper verb.

Section 15, line 2 references workpieces "33b" incorrectly while it may be corrected to read "33c".

Section 15, line 5 the "closed position" seems to be incorrect and it may be corrected to read "open position".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 14-17, 19, 20, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukuroi (US 2002/0170164).

As for claim 14, Fukuroi in disclosing a manufacturing method of magnetic head slider teaches about:

(a) providing a workpiece (stuck row bars 51, Fig. 5) in a first configuration;

(b) mounting the workpiece (51) on a fixture (UV tape 50, Fig. 5);

- (c) processing the workpiece (51) while mounted on fixture (50);
- (d) cutting the workpiece (51) into individual pieces (individual magnetic head sliders 101, Fig. 10b) while in first configuration;
- (e) fixture (50) with individual workpieces (101) mounted to it is further articulated and positioned to receive a laser beam (Fig. 11, step S16) in a second configuration;
- (f) individual workpieces (101) while attached to fixture (50) are positioned on the top of receptacles (fixing jig 60, working table 90, Fig. 9);
- (g) dismounting and detaching the individual workpieces (101) from the fixture (50) such that individual workpieces (101) remain in the receptacles (60, 90) (see Fig. 11, step S19).

As for claim 15, the workpiece (51) in step (a) is in an elongated row (Fig. 5) and in step (e) the individual workpieces (101) are in elongated row and spread apart (Fig. 10b).

As for claim 16, the workpiece (51) in step (b) is bonded to fixture (50) (Fig. 5).

As for claim 17, the workpiece (51) in step (a) is a stuck row bar with a plurality of aligned thin-film magnetic head elements (Fig. 10a) and in step (d) the workpiece (51) is cut into individual magnetic head sliders (101) (Fig. 10b).

As for claim 19, the receptacle (60) is an inspection tray thus allowing a crown amount of each individual workpiece (101) to be inspected and measured (Fig. 11, step S17).

As for claim 20, the individual workpieces (101) are debonded and detached from fixture (50) (Fig. 11, step 19).

As for claim 23, the individual workpieces (101) are all co-planar in both the first and second configurations (Fig. 10b).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuroi in view of Tanemura (US 6,551,438). Fukuroi in disclosing all the claim limitations does not explicitly teach about automatically transferring of workpieces to the receptacles. However, Tanemura in disclosing a method of manufacturing magnetic head slider and fixing row bars, teaches about a row bar aligner (6) that includes a robot (64) driven by controller C for automatically picking up row bars (5) one by one and transferring them to a carrier (70) in order to align a plurality of row bars (5) in such a manner that their surfaces to be processed are in line with a predetermined reference plane (Fig. 5). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Fukuroi by using a robot as taught by Tanemura to provide an effective manual-free and automatic method of transferring workpieces.

Allowable Subject Matter

Claims 18 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent forms including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarang Afzali whose telephone number is 571-272-8412. The examiner can normally be reached on 7:00-3:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.A.


PETER VO
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